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EXAMINER

LAU, JONATHAN S

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1623

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ELECTRONIC

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ADVISORY ACTION

Continuation of 11. Applicant's Remarks, filed 14 July 2008, have been fully considered and not found to be persuasive.

Applicant reiterates the same remarks that that the instant invention as claimed is distinct from Ueno et al. '388 (US Patent 5,304,388, of record). Applicant emphasizes the second maltitol aqueous solution is a liquid. However, while the claims are read in view of the specification, the specific limitation that the second maltitol aqueous solution is present in the form of a liquid is not found in the claim. As provided for in the cited definition of solution (definition of solution, Dictionary.com, of record) the phrase "aqueous solution" does not require the solution be in the liquid phase, but also encompasses a solid that is a homogenous mixture of two or more substances. Therefore the seed crystal disclosed by Ueno '388 meet the limitation of a second maltitol aqueous solution according to the language of the instant claim.

Applicant asserts the water contained in the seed crystal, or second maltitol aqueous solution, does not meet the limitation of instant claim 3. The interpretation of instant claim 3, a process described using the open claim language of "comprising", does not limit the step of addition of water to the addition of only water of a certain degree of purity, such as service water (instant specification page 5, line 19-20) or ion exchanged water (instant specification page 8, line 10), but includes the addition of water contained in a solution, such as in the seed crystal containing a percentage of water, or the second maltitol aqueous solution. While the claim is interpreted in view of

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the specification, the specification is not read into the limitations of the invention as claimed.

Applicant remarks that the “temperature lower than 140°C” is the temperature of the raw material of the maltitol solution in the stirrer and not the temperature of the seed crystal to be added. However, it is expected that the seed crystal would warm up prior to contact with the raw material of the maltitol solution. Ueno ‘388 teaches the seed crystal used in as small a fraction as 1% by weight of the total amount of maltitol (column 4, lines 15-17). Therefore is a reasonable expectation that a small amount of material added to material maintained at a “temperature lower than 140°C” and mechanically agitated would be heated up prior to the contact with the raw material of the maltitol solution, the moment at which the material can be said to have been added.

Applicant remarks that the instant invention differs from the invention of Numi ‘473 and therefore the reason to combine Ueno ‘388 and Numi ‘473 achieves different goals than the instant invention of producing crystalline maltitol without adding seed crystals by an advantageously simple method. However, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant, see MPEP 2144 IV. The combination of Ueno ‘388 and Numi ‘473 to substitute equivalents known in the prior art to modify Ueno ‘388 does not necessarily achieve the same advantage or result discovered by applicant, and the combination makes obvious the limitations of the instant invention according to the language of the instant claims.

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Applicant asserts that feeding a seeded oversaturated maltitol aqueous solution into a continuous kneader will block the material injection port. However, it is noted that Numi '473 teaches an oversaturated maltitol-containing solution contains preferably at least about 85% by weight maltitol (page 4, lines 27-28). Ueno '388 teaches the use of an seeded aqueous solution of maltitol of preferably not less than 85% by weight (column 2, lines 45-49), and teaches the use a continuous-type mixing kneader (column 4, lines 65-66), suggesting that any such potential difficulties with the feeding of seeded oversaturated maltitol aqueous solutions have been overcome in the prior art.

/Shaojia Anna Jiang, Ph.D./

Supervisory Patent Examiner, Art Unit 1623